

# Notice of Allowability

Application No.

09/801,752

Examiner

Humera N. Sheikh

Applicant(s)

SCHMIDMAIER ET AL.

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 27 April 2005.
2. ☒ The allowed claim(s) is/are 1-6, 8-30 and 60-64.
3. ☒ The drawings filed on 09 March 2001 are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☒ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying Indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

## Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date 07/03/01; 11/06/03
4. ☐ Examiner's Comment Regarding Requirement for Deposit  
of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

*James M. Spear*  
JAMES M. SPEAR

PRIMARY EXAMINER

AU 1618

## **DETAILED ACTION**

### **Status of the Application**

Receipt of the Request for Continued Examination (RCE) under 37 C.F.R. 1.114, Applicant's Amendment, Remarks/Arguments and the request for extension of time (1 month-granted), all filed 04/27/05 is acknowledged.

This application is in condition for allowance except for the presence of claims 32-59 drawn to an invention non-elected without traverse. Accordingly, claims 32-59 have been cancelled.

Claims 1-6, 8-30 and 60-64 are pending. Claims 1-6, 8-30 and 60-63 have been amended. Claim 31 has been cancelled (Examiner acknowledges Applicant's right to prosecute subject matter of the cancelled claim in related application(s)). Claims 32-59 have been cancelled by Examiner's Amendment. Claims 1-6, 8-30 and 60-64 are allowed.

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 04/27/05 has been entered.

### EXAMINER'S AMENDMENT

The application has been amended as follows:

In the Claims:

Claims 32-59 have been cancelled.

### *Allowable Subject Matter*

Claims 1-6, 8-30 and 60-64 are allowed.

The following is an examiner's statement of reasons for allowance:

The primary reasons for allowance are that the prior art (Arm *et al.* WO 93/20859; Bates *et al.* US 6,530,951 B1; Eitenmuller *et al.* US 4,610,692 ; Healy *et al.* US 5,670,161) do not disclose nor fairly suggest an implant comprising a varnish-like coating having a thickness of 100  $\mu\text{m}$  or less and made of a biodegradable polymer having a mean molecular weight of 100 kDa or less, wherein the varnish-like coating forms an adhesive bond to the surface of the implant. The 'varnish-like coating' of the instant invention is an improvement over prior art formulations because the varnish-like coating provides for a coating that bonds with the surface of the base material of an implant with enough adhesive strength such that, when the implant is implanted, mechanical friction will not abrade or otherwise damage the coating. It is this adhesive strength that ensures the coating is not degraded during insertion of the implant into the body. The prior art also fails to teach a varnish-like coating that is made by mixing a biodegradable polymer with an organic solvent to form a dispersion, applying the dispersion on a surface of the implant and then evaporating the organic solvent. In contrast, the prior art teaches

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prefabricated films, such as those taught by Arm *et al.* (WO '859), for example. The instant implant promotes acceleration of the healing process for treating pathological changes or conditions in the spinal column and/or locomotor system and thus demonstrates an improvement over prior art formulations. Accordingly, the instant invention is rendered non-obvious and patentable over the cited art of record.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Humera N. Sheikh whose telephone number is (571) 272-0604. The examiner can normally be reached on Monday through Friday from 8:00A.M. to 5:30P.M., alternate Fridays off.

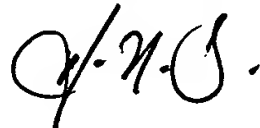
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (571) 272-0602. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

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applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

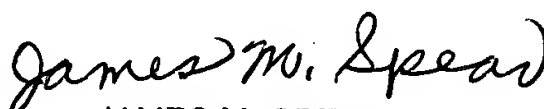
H. N. Sheikh



Patent Examiner

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June 11, 2005



JAMES M. SPEAR  
PRIMARY EXAMINER

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